

REMARKS/ARGUMENTS

STATUS OF CLAIMS

In response to the Office Action dated September 4, 2007, claim 9 has been amended.

Claims 1-4, 9 and 11 are now pending in this application. No new matter has been added.

Claim 9 has been amended to remove the single parenthesis ")" after "bore" in line 3.

The claim amendment is a non-narrowing claim amendment.

The indication that claims 1-4 and 9 are allowable, and that claim 11 is objected to, but would be allowable if amended to overcome noted indefiniteness, is acknowledged and appreciated.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 11 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner maintains that it is unclear whether "steps of degreasing and sintering are never performed at all in the method of claim 11, or that steps of degreasing and sintering could be performed in the method of claim 11 as long as they are not performed between the steps of injection molding and the step of cooling the injection-molded compact."

The rejection is respectfully traversed.

Case law precedent has established that an analysis under 35 U.S.C. § 112 begins with a determination of whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. Claim language is viewed not in a vacuum, but in light of the teachings of the prior art and of the application disclosure as it would be interpreted by

one possessing the ordinary level of skill in the art. *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977); *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971).

A decision on whether a claim is invalid under this section of the statute requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification, *Seattle Box Co. v Industrial Crating & Packing*, 731 F.2d 381, 385, 221 U.S.P.Q. 568, 574 (Fed. Cir. 1984).

In determining definiteness, no claim may be read apart from and independent from the disclosure on which it is based. *In re Cohn*, 169 U.S.P.Q. 95, 98 (CCPA 1971); *In re Kroekel*, 183 U.S.P.Q. 610, 612 (CCPA 1974):

... claims are not to be considered in a vacuum, "but always in light of the teachings of the prior art and the particular application disclosure as it would be viewed by one possessing the ordinary level of skill in the pertinent art." When considered in light of the prior art and the specification, claims otherwise indefinite may be found reasonably definite.

The Examiner's question and problem concerning clarity results from the fact that the Examiner is reading the claim in a vacuum and not in light of the specification. This feature of claim 11 is based upon the description, for example, at page 2, lines 11-17, page 4, lines 8-18, page 7, lines 5-22 and page 16, lines 11-16. The description in the specification, as well as claim 11, refer only to the fact that cooling the injection-molded compact for solidification is done *without performing steps of degreasing and sintering between the step of injection molding and the step of cooling the injection-molded compact*. Whether or not the "steps of degreasing and sintering are never performed at all in the method of claim 11" is a question that is beyond the scope of what is recited in claim 11 and a response to such question is not necessary in order to determine whether or not the prior art meets the terms of the claims.

More specifically, what the prior art must show with respect to the features of claim 11 is that (i) there is kneading a thermoplastic resin consisting of at least one of polypropylene and methylpentene polymer blended with 30-58% by volume of soft magnetic material powder having a scale-like shape and an aspect ratio of 3-20 and a mean particle diameter converted to spherical diameter of 5-50 μm and with 1-9% by volume of a molding assistant and a kneading assistant to provide a kneaded material, (ii) there is injection-molding the kneaded material to provide a compact, and (iii) there is cooling the injection-molded compact for solidification *without performing steps of degreasing and sintering between the step of injection molding and the step of cooling the injection-molded compact.* Whether “steps of degreasing and sintering are never performed at all in the method of claim 11, or that steps of degreasing and sintering could be performed in the method of claim 11 as long as they are not performed between the steps of injection molding and the step of cooling the injection-molded compact” is just not relevant to the scope of claim 11.

The scope of claim 11 is such that a reference that presumably meets the limitations of kneading a thermoplastic resin consisting of at least one of polypropylene and methylpentene polymer blended with 30-58% by volume of soft magnetic material powder having a scale-like shape and an aspect ratio of 3-20 and a mean particle diameter converted to spherical diameter of 5-50 μm and with 1-9% by volume of a molding assistant and a kneading assistant to provide a kneaded material, injection-molding the kneaded material to provide a compact, and cooling the injection-molded compact for solidification *that also never performs steps of degreasing and sintering* would seem to meet the terms of claim 11. However, the scope of claim 11 is also such that a reference that presumably meets limitations of kneading a thermoplastic resin

consisting of at least one of polypropylene and methylpentene polymer blended with 30-58% by volume of soft magnetic material powder having a scale-like shape and an aspect ratio of 3-20 and a mean particle diameter converted to spherical diameter of 5-50 μm and with 1-9% by volume of a molding assistant and a kneading assistant to provide a kneaded material, injection-molding the kneaded material to provide a compact, and cooling the injection-molded compact for solidification *that also performs steps of degreasing and sintering* would seem to meet the terms of claim 11 if the steps of degreasing and sintering are not performed *between the step of injection molding and the step of cooling the injection-molded compact.*

It is submitted that when the claim language is read in light of the present specification, an artisan would readily understand the metes and bounds of the claimed invention. The fact that a claim is broad does not justify a rejection on the ground that the claim is indefinite or incomplete (see § 706.03(d) of the M.P.E.P.). Therefore, it is believed that claim 11 is definite, and it is respectfully urged that the rejection be withdrawn and that claim 11 be allowed.

CONCLUSION

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ed J. Wise Reg. No. 34,523 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

By 

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